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10/057,660	01/25/2002	Karlheinz Bortlik	88265-6773	4348

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EXAMINER

DAVIS, RUTH A

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1651

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/057,660
Filing Date: January 25, 2002
Appellant(s): BORTLIK ET AL.

Robert M. Barrett
For Appellant

EXAMINER'S RESPONSE TO REPLY BRIEF

Responsive to the Reply Brief filed on October 19, 2007, a supplemental Examiner's
Answer is set forth below:

Claims 65 – 76, 78 – 82 and 86 – 93 are pending and are under appeal.

Response to Arguments

Appellant argues that the examiner has not properly interpreted the claims, specifically in that the terms “mixture” and “homogenous” are not considered to be equivalent, as read in light of the specification. Appellant argues that the plain meaning of “mixture” must be applied in conjunction with the examples in the specification which indicate homogenous mixtures and solutions are disclosed and used to make the invention. Appellant further argues that Schmitz does not teach homogenous mixtures and therefore the reference does not inherently anticipate the claims; and relies upon the affidavit filed on November 22, 2006 to further support the argument.

However, these arguments and the affidavit fail to persuade because as stated in the Examiner’s Answer, the specification fails to specifically define the term “mixture”, thus the term is presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art (MPEP 2111.01III). Thus, while the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.1993). While it is acknowledged that the specification exemplifies homogenous solutions, it is reiterated that the claim language does not require a homogenous mixture, but a mixture. As previously stated, as defined by “On-Line Medical Dictionary”, the term mixture is not equivalent to the term homogeneous. Specifically, a mixture is defined as a variable composition containing 2 or more substances; while

homogeneous is defined as consisting of similar elements with a uniform quality (see attachment). Thus, these terms are not considered interchangeable.

Even if the claims were limited to such a homogeneous composition, or even if the term “mixture” is interpreted to mean “homogenous”, it is noted that examples 5 and 6 clearly teach a homogeneous blend of whey and LBC as the first component. Thus, the teachings of Schmitz clearly encompass the homogenous composition argued by appellant. Furthermore, it is reiterated that Schmitz clearly teaches the claimed amounts of whey and LBC homogenized together in a single composition (example 6, first component). Thus the composition of Schmitz must necessarily perform the functions as disclosed by appellants. Otherwise appellants’ invention could not function as claimed. Furthermore, it is reiterated that “[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.” (MPEP 2112) In addition, “There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention” (MPEP 2112). Moreover, the first component of Schmitz does, in fact, inherently teach the claimed composition.

For these reasons, the claims stand rejected and under appeal.

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Appellant may file another reply brief in compliance with 37 CFR 41.41 within two months of the date of mailing of this supplemental examiner's answer. Extensions of time under 37 CFR 1.136(a) are not applicable to this two month time period. See 37 CFR 41.43(b)-(c).

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

/Ruth A Davis/

Primary Examiner, AU 1651


Bruce M. Kisiluk, Director
Technology Center 1600